

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 24, 2004. In order to advance prosecution of this case, Applicants amend Claims 14-17. Applicants respectfully request reconsideration and favorable action in this case.

Allowable Subject Matter

Applicants note with appreciation the indication by the Examiner that Claim 21 is objected to as being dependent upon a rejected base claim, but is directed to allowable subject matter if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For the reasons discussed below, Applicants respectfully contend that Claim 21 is currently in condition for allowance.

Specification Objections

The Office Action objected to the specification “as failing to provide proper antecedent basis for the claimed subject matter.” Applicants have amended the specification herein and submit that no new matter has been added because the subject matter added to paragraph 00051 was in the original disclosure (*see, e.g.*, original Claim 8). Reconsideration and favorable action are respectfully requested.

Claim Objections

Claims 14-17, 19 & 21-24 were objected to because of informalities. Applicants have amended independent Claim 14 to overcome any informalities that may have been present. Applicants note that the word “recovering” in line 1 of Claim 14 was not changed to “separating,” nor is it required to be changed. There is support in the specification for this language (*see, e.g.*, paragraph 0001). Reconsideration and favorable action are respectfully requested.

Section 103(a) Rejections

The Office Action rejects Claims 14-17, 19 and 22-24 under 35 U.S.C. §103(a) as being unpatentable over European Patent No. EP 0764627 issued to Ohkoshi et al. (“EP

'627") in view of Applicants' Disclosure of Admitted Prior Art ("AAPA"). Applicants respectfully traverse these rejections for the reasons stated below.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143.

First, Applicants respectfully submit that neither *EP '627* nor *AAPA*, alone or in combination, discloses, teaches, or suggests each and every limitation of independent Claim 14, as amended. For example, the *EP '627 – AAPA* combination proposed by the Examiner fails to disclose, teach, or suggest "condensing the vapor stream to generate low pressure steam at a pressure level from 0.7-2.0 kilograms/cm²," as recited in Applicants' independent Claim 14. The Examiner admits at page 3 of the Office Action that *EP '627* does not disclose this limitation, but uses *AAPA* to teach this limitation. However, *AAPA* merely discloses at paragraph 00039 that "[t]ypically, a conventional dehydration column generates low pressure steam (typically 0.6-0.7kg/cm² g) at the top of the column." Nowhere does *AAPA* disclose that the low pressure steam is at a pressure level from 0.7-2.0 kilograms/cm². Thus, for at least this reason, the *EP '627 – AAPA* combination proposed by the Examiner fails to disclose, teach, or suggest each and every limitation of independent Claim 14, as amended. Therefore, a *prima facie* case of obviousness has not been established.

Second, Applicants also respectfully note that the Examiner has not provided the required evidence of a suggestion to combine *EP '627* and *AAPA*. As mandated by the Federal Circuit, "[a] factual inquiry whether to combine references must be thorough and searching." *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Any "conclusory statements . . . do not adequately address the issue of motivation to combine." *Id.* The Examiner simply states at page 4 of the Office Action that "[i]t would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the limitation admitted by Applicants to the process of *EP '627* inasmuch as both references are directed to similar processing environment, i.e., to producing highly pure terephthalic acid." There is simply no "factual inquiry" in this statement. Thus, this reasoning surely cannot be

said to be “thorough and searching.” Therefore, for this additional reason, a *prima facie* case of obviousness has not been established. Thus, independent Claim 14, as amended, is allowable. Reconsideration and favorable action are respectfully requested.

Dependent Claims 15-17, 19 and 21-24 depend from independent Claim 14 and are also not rendered obvious by the *EP '627 – AAPA* combination proposed by the Examiner because they include the limitations of independent Claim 14 as well as additional limitations that further distinguish *EP '627* and *AAPA*. Reconsideration and favorable action are respectfully requested.

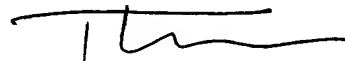
CONCLUSIONS

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other apparent reasons, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe no fee is due. However, should there be a fee discrepancy, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. **02-0384** of **Baker Botts L.L.P.**

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants



Thomas A. Beaton
Reg. No. 46,543
PHONE: (214) 953-6464

Date: 2/23/05

CORRESPONDENCE ADDRESS:

Customer Number: **05073**
Attorney Docket No.: 064977.0133